

Application No. 09/994,492
Amendment dated February 7, 2005
Reply to Final Office Action of November 19, 2004

REMARKS

Claims 1-6, 8-14, 16-18, 21-23, 25-27, 30-35, and 43-47 are pending in the application. The Examiner rejected Claims 1-6, 8-14, 16-18, 21-23, 25-27, 30-35, and 43-47.

Specification

The specification has been amended to correct minor errors.

Abstract

The Abstract has been amended to correct minor errors.

Claim Rejections – 35 U.S.C. §103

The Examiner rejected Claims 1-6, 8-14, 16-18, 21-23, 25-27, and 30-35 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,221,744 (hereinafter "Stryker '744") in view of U.S. Patent No. 3,716,057 (hereinafter "Rubin '057"). Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based upon Stryker '744 and Rubin '057.

It is well settled that "the Examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). It is equally well settled that "a *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Bell*, 991 F.2d 781, 782 (Fed. Cir. 1993)). Stated another way, "(t)he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)). Not only must the Examiner bear the burden of showing a teaching or suggestion to combine references to establish a 35 U.S.C. § 103 obviousness rejection, but the Examiner must also indicate where such a teaching or suggestion can be found in the relevant reference. See *In re Yates*, 663 F.2d 1054 (CCPA 1981) (when the PTO asserts

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that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference). Additionally, the Federal Circuit has counseled that "the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness." *Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 1343 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted)).

Applicant respectfully submits that neither Stryker '744 nor Rubin '057 contain a teaching, suggestion, or motivation for their combination. Stryker '744 discloses surgical knife 10 designed for use in removing the semilunar cartilage from a knee including blade supporting head 12 as an integral extension of neck 13, as shown in Figures 1-3. Head 12 is of approximately the same thickness as neck 13 but is slightly broader to accommodate blade 14. Rubin '057 discloses a chisel designed for cutting bony tissue including handle or shaft portion 10 terminating in blade 12 at one end thereof, as shown in Fig. 1. Blade 12 is formed with protuberances 16 and includes cutting edge 14 at its central portion. The Examiner indicated that it would have been obvious to a person of ordinary skill in the art to modify probes 17 and 18 of Stryker '744 to have a thickness greater than head 12 to guard against slippage of surgical knife 10. Applicant respectfully submits that there is no motivation to modify probes 17 and 18 of Stryker '744 to have a thickness greater than head 12. Probes 17 and 18 do not require a thickness greater than head 12 to guard against slippage of blade 14 because blade 14 is already protected from slippage via the recessed location of blade 14 within probes 17 and 18.

Additionally, Stryker '744 discloses a surgical knife for removal of soft, flexible tissue, specifically, the semilunar cartilage from the knee. In contrast, Rubin '057 discloses a chisel for removing hard tissue, specifically, bone. Applicant respectfully submits that a person of ordinary skill in the art would not be motivated to combine the surgical knife of Stryker '744, which is directed to the removal of soft tissue, with the chisel of Rubin '057, which is directed to

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the removal of hard tissue. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of Claims 1-6, 8-14, 16-18, 21-23, 25-27, and 30-35.

The Examiner rejected Claims 43-47 under 35 U.S.C. §103(a) as being unpatentable over Stryker '744 in view of U.S. Patent No. 5,391,169 (hereinafter "McGuire '169").

McGuire '169 discloses patellar tendon harvester 10 including handle portion 12 and two-tined fork 16 connected together by bent stem portion 14, as shown in Figs. 1-2. A surgeon is able to insert harvester 10 within an incision in a body and control harvester 10 from outside the incision because handle portion 12 is offset from two-tined fork 16 via bent stem portion 14. Applicant respectfully submits that a combination of Stryker '744 with McGuire '169 does not yield the ligament cutter called for in Claims 43-47, including a head with a blade and spacer means or joint spacers offset from the head, but rather yields the surgical knife of Stryker '744 with an offset handle as in McGuire '169.

Even taking blades 17 of McGuire '169 as the claimed spacer means or joint spacers, the combination of Stryker '744 with McGuire '169 still does not yield the claimed invention. Claims 43-47 all call for a ligament cutter including a head having a distal end with a blade and spacer means or joint spacers. Taking blades 17 of McGuire '169 as the claimed spacer means or joint spacers, head 20 does not include a blade as called for in Applicant's Claims 43-47. To the contrary, the joint spacer includes a blade. Combining Stryker '744 with McGuire '169 would yield an instrument having a head with a blade extending downwardly therefrom and not a head having a distal end with a blade as called for in Applicant's Claims 43-47. For example, modifying Stryker '744 in accordance with McGuire '169 would require movement of blade 14 of Stryker '744 from its position within head 12 to a position extending below head 12 as in McGuire '169. Because the combination of Stryker '744 with McGuire '169 does not yield a ligament cutter including a head having a distal end with a blade and spacer means or joint spacers offset from the head as called for in Claims 43-47, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of Claims 43-47.

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It is believed that the above represents a complete response to the Official Action and reconsideration is requested. Specifically, Applicant respectfully submits that the current application is in condition for allowance and such action is earnestly solicited.

In the event Applicant has overlooked the need for an extension of time or payment of fee, Applicant hereby petitions therefor and authorizes that any charges be made to Deposit Account No. 02-0385, BAKER & DANIELS.

If any questions concerning this application should arise, the Examiner is encouraged to telephone the undersigned at 260/424-8000.

Respectfully submitted,

BAKER & DANIELS

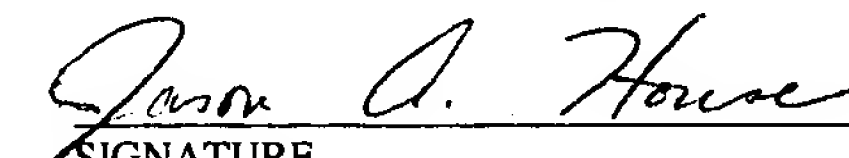

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NAME OF REGISTERED REPRESENTATIVE


SIGNATURE

February 7, 2005
DATE